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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,159	08/23/2001	Paul Clinton Coffin	10012828-1	1251

7590 03/23/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

TRAN, HANH VAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,159

Applicant(s) *SN*

COFFIN ET AL.

Examiner

Hanh V. Tran

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→ The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 1/2/2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,116,063 to Foslien in view of USP 6,480,391 to Monson et al.

Foslien discloses a data storage system comprising a media storage device having all the elements recited in the above listed claims including, such as shown in Figs 2-3, a housing 54 movable between a storage position within the data storage system and an extended position, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle operationally attached to the housing, a side portion of the housing having a plurality of slots (56,58) configured to receive the data media, a

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spring mechanism of a metallic strip configured to engage the data media when received within the slots, a plurality of dividers positioned in spaced-apart relation within the housing. Foslien further discloses it is well known that a data storage system (column 5, lines 3-30) including a picker assembly/a media handling system for transferring data media 60,62 from the media storage device to a data exchange device. The different being that Foslien does not clearly disclose the housing having means for slidably inserting and removing the media storage device within the opening in the data storage system, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located adjacent an opening in the data storage system.

Monson et al discloses a media storage device comprising a housing 95 having means for slidably inserting and removing the media storage device within the opening in the data storage system, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located adjacent an opening in the data storage system in order to facilitate inserting and removing the housing from the data storage system. Therefore, it would have been obvious to modify the structure of Foslien by providing the housing with means for slidably inserting and removing the media storage device within the opening in the data storage system, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located

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adjacent an opening in the data storage system in order to facilitate inserting and removing the housing from the data storage system, as taught by Monson et al, since both teach alternate conventional media storage device structure, used for the same intended purpose, thereby providing structure as claimed.

Response to Arguments

5. Applicant's arguments filed 1/2/2004 have been fully considered but they are not persuasive. In response to applicant's argument on page 6 that neither the '063 patent nor the '391 patent "disclose, teach, or suggest the limitations/features/elements of a data exchange device or a media handling system as recited in new independent claims 21 and 30", the examiner take the position that it is inherent from the disclosure of the '063 patent that the autochanger and picker assembly including the above mentioned data exchange device and media handling system.

6. In response to applicant's argument that the cited references fail to teach the limitations of "a media storage device for storing a plurality of data media", the examiner take the position that the '063 patent clearly disclose a media storage device for storing a plurality of data media 60,62, such as stated in column 5, lines 3-30.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (703) 308-6302. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVT *HVT*
March 17, 2004

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Lanna Mai